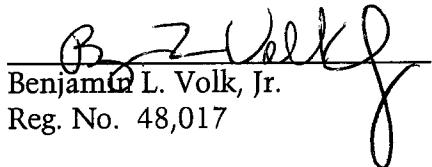


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is being electronically filed with the United States Patent and Trademark Office via the EFS web on October 30, 2008.


Benjamin L. Volk, Jr.
Reg. No. 48,017

| | | |
|---|---|-----------------------------|
| In re application of: | : | |
| Ewing B. Gourley | : | |
| Serial No.: 09/710,227 | : | Examiner: Porter, Rachel L. |
| Filed: November 10, 2000 | : | Group Art Unit: 3626 |
| For: Method and Apparatus for Processing Pharmaceutical Orders to Determine Whether A Buyer of Pharmaceuticals Qualifies for an "Own Use" Discount | : | |

Reply Brief Under 37 CFR 41.43(b)

In response to the "Examiner's Answer" dated September 18, 2008, Applicant submits the following as its Reply Brief pursuant to 37 CFR 41.43(b) in connection with the appeal of the above-referenced patent application.

*I. The "Examiner's Answer" dated September 18, 2008, is a
"Supplemental Examiner's Answer"*

The "Examiner's Answer" dated September 18, 2008 purports to be in response to Appellant's appeal brief filed February 14, 2008. (See "Examiner's Answer" of September 18, 2008; page 1) However, Applicant respectfully submits that the record shows this September 18, 2008 paper is in fact a "Supplemental Examiner's Answer" because it was issued by the Examiner after Appellant had already filed its Reply Brief to the Examiner's Answer of May 2, 2008. The timeline of filings in connection with this appeal is as follows:

- 02-14-2008 Amended Appeal Brief Filed
- 05-02-2008 Examiner's Answer Mailed
- 07-01-2008 Reply Brief Filed
- 09-18-2008 New "Examiner's Answer" Mailed

In view of the September 18, 2008 Examiner's Answer being issued by the USPTO over two months after Appellant had already filed its Reply Brief, Applicant respectfully submits that the Examiner's Answer dated September 18, 2008 must be treated as a Supplemental Examiner's Answer. Further supporting this interpretation of the record is the USPTO's Patent Application Information Retrieval (PAIR) system, which lists the September 18, 2008 Examiner's Answer as a "Supplemental Examiner's Answer" in the transaction history for this application. (See Exhibit 1 attached herewith).

II. USPTO Rules Prohibit the Entry of New Grounds of Rejection in a Supplemental Examiner's Answer

The Examiner improperly raised a new ground of rejection in the Supplemental Examiner's Answer, in violation of 37 CFR 41.43(a)(2). The new grounds of rejection begin on page 2 of the Supplemental Examiner's Answer, and consists of the rejection of multiple claims based on 35 USC 101. 37 CFR 41.43(a)(2) unequivocally states that "[a] supplemental examiner's answer responding to a reply brief may not include a new ground of rejection". As stated in MPEP 1207.05(I):

37 CFR 41.43(a)(2) prohibits a supplemental examiner's answer responding to a reply brief from including a new ground of rejection. After the filing of a reply brief, any new ground of rejection responding to a reply brief must be by way of reopening of prosecution." (See MPEP 1207.05(I); see also MPEP 1207.05(A) ("The examiner may NOT include a new ground of rejection in the supplemental examiner's answer responding to a reply brief." (emphasis in original))).

Because the Examiner's Answer dated September 18, 2008 must be deemed a Supplemental Examiner's Answer in response to Appellant's Reply Brief given that Appellant filed the Reply Brief over two months before the September 18, 2008 Examiner's Answer, Applicant

Application No. 09/710,227
Attorney Docket No. 66790-6411

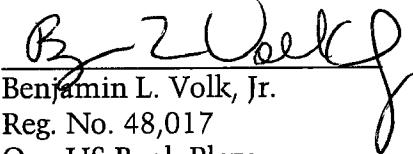
respectfully submits that 37 CFR 41.43(a)(2) bars entry of the new grounds of rejection contained in the September 18, 2008 Examiner's Answer. Thus, for the reasons expressed herein, Applicant respectfully submits that the new grounds of rejection contained in the September 18, 2008 Examiner's Answer must be withdrawn and the appeal must move forward without such new grounds of rejection. Applicant also reserves the right to file a petition under 37 CFR 1.181 to request that the impermissible new ground of rejection be withdrawn.

Favorable action is respectfully requested.

Respectfully submitted,

Thompson Coburn LLP

By:


Benjamin L. Volk, Jr.
Reg. No. 48,017
One US Bank Plaza
St. Louis, MO 63101-1693
(314) 552-6000
(314) 552-7000 (fax)

| | | |
|------------|---|----------------------|
| 09/710,227 | Method and apparatus for processing pharmaceutical orders to determine whether a buyer of pharmaceuticals qualifies for an "own use" discount | 10-30-2008::14:58:12 |
|------------|---|----------------------|

Transaction History

| Date | Transaction Description |
|------------|--|
| 09-18-2008 | Electronic Review |
| 09-18-2008 | Email Notification |
| 09-18-2008 | Mail Supplemental Examiner's Answer |
| 09-15-2008 | 2nd or Subsequent Examiner's Answer to Appeal Brief |
| 07-03-2008 | Date Forwarded to Examiner |
| 07-01-2008 | Reply Brief Filed |
| 05-06-2008 | Electronic Review |
| 05-05-2008 | Exam. Ans. Review Complete |
| 05-03-2008 | Email Notification |
| 05-02-2008 | Mail Examiner's Answer |
| 04-29-2008 | Examiner's Answer to Appeal Brief |
| 02-25-2008 | Appeal Brief Review Complete |
| 02-25-2008 | Date Forwarded to Examiner |
| 02-14-2008 | Appeal Brief Filed |
| 01-15-2008 | Email Notification |
| 01-14-2008 | Notice -- Defective Appeal Brief |
| 01-09-2008 | Appeal Brief Review Complete |
| 01-09-2008 | Date Forwarded to Examiner |
| 12-19-2007 | Defective / Incomplete Appeal Brief Filed |
| 12-19-2007 | Appeal Brief Filed |
| 11-21-2007 | Email Notification |
| 11-20-2007 | Notice -- Defective Appeal Brief |
| 08-29-2007 | Date Forwarded to Examiner |
| 08-28-2007 | Defective / Incomplete Appeal Brief Filed |
| 08-28-2007 | Appeal Brief Filed |
| 08-28-2007 | Request for Extension of Time - Granted |
| 01-29-2007 | Notice of Appeal Filed |
| 01-29-2007 | Request for Extension of Time - Granted |
| 07-28-2006 | Mail Final Rejection (PTOL - 326) |
| 07-24-2006 | Final Rejection |
| 03-24-2006 | Date Forwarded to Examiner |
| 03-16-2006 | Response after Non-Final Action |
| 03-16-2006 | Request for Extension of Time - Granted |
| 11-14-2005 | Mail Non-Final Rejection |
| 09-16-2005 | IFW TSS Processing by Tech Center Complete |
| 08-06-2001 | New or Additional Drawing Filed |
| 08-24-2001 | Information Disclosure Statement considered |
| 08-22-2005 | Non-Final Rejection |
| 06-04-2005 | Date Forwarded to Examiner |
| 05-12-2005 | Response to Rule 105 Required for Information Filed |
| 03-10-2005 | Mail Independent Rule 105 Communication |
| 03-07-2005 | Requirement under Rule 105 - Independent Communication |
| 12-28-2004 | Date Forwarded to Examiner |
| 11-05-2004 | Response to Election / Restriction Filed |
| 11-05-2004 | Workflow incoming amendment IFW |

EXHIBIT

tables

/

| | |
|------------|--|
| 10-04-2004 | Mail Restriction Requirement |
| 09-30-2004 | Requirement for Restriction / Election |
| 07-02-2004 | Case Docketed to Examiner in GAU |
| 01-07-2004 | Correspondence Address Change |
| 11-18-2002 | Case Docketed to Examiner in GAU |
| 01-24-2002 | Case Docketed to Examiner in GAU |
| 01-24-2002 | Case Docketed to Examiner in GAU |
| 01-17-2002 | Case Docketed to Examiner in GAU |
| 01-17-2002 | Case Docketed to Examiner in GAU |
| 01-16-2002 | Case Docketed to Examiner in GAU |
| 01-16-2002 | Case Docketed to Examiner in GAU |
| 11-26-2001 | Case Docketed to Examiner in GAU |
| 08-24-2001 | Information Disclosure Statement (IDS) Filed |
| 08-24-2001 | Information Disclosure Statement (IDS) Filed |
| 03-09-2001 | Case Docketed to Examiner in GAU |
| 02-12-2001 | Application Dispatched from OIPE |
| 02-12-2001 | Correspondence Address Change |
| 12-09-2000 | IFW Scan & PACR Auto Security Review |
| 11-10-2000 | Initial Exam Team nn |

[Close Window](#)